



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

X9

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/096,593	06/12/1998	STEPHEN D. O'CONNOR	A-64559-3/RT	1989
7590	05/26/2005		EXAMINER	
RICHARD F TRECARTIN FLEHR HOHBACH TEST ALBRITTON AND HERBERT FOUR EMBARCADERO CENTER SUITE 3400 SAN FRANCISCO, CA 941114187			COOK, LISA V	
			ART UNIT	PAPER NUMBER
			1641	
DATE MAILED: 05/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/096,593	O'CONNOR ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Lisa V. Cook	1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2.  The Notice of Appeal was filed on 25 April 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  They raise the issue of new matter (see NOTE below);
  - (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 20,22,23 and 30-35.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 4/25/05 Not Considered

13.  Other: \_\_\_\_\_.

LONG V. LE *Long V. Le*  
 SUPERVISORY PATENT EXAMINER *15/05*  
 TECHNOLOGY CENTER 1600  
*Jonelle, 05/14/05*

Continuation of 3. NOTE: The amendment filed 4/25/05 requires additional search and consideration because it introduces new claim limitations. Specifically, the claims have been modified to read on a protein target instead of a non-nucleic acid target and further include a passivation agent monolayer comprising a protein binding ligand and two passivation species. These limitations raise new issues that require further search and consideration with respect to the prior art. Further, Applicant has not cited support in the disclosure for a passivation agent monolayer comprising two passivation species and a protein binding ligand and the examiner did not find support. This raises the issue of new matter. Applicant is invited to show support for the new claim limitations. The amendment also adds new claim 36 without canceling a corresponding number of finally rejected claims.

The information disclosure statement filed after final on 4/25/05 will not be considered because prosecution is closed in the Final Action. See MPEP 609 section C

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application.

  
Michael J. Cook  
5/13/05

***Request for Reconsideration***

1. Applicants arguments After Final filed 4/25/05 are acknowledged. The amendments filed therein will not be entered. Please see PTOL-303 included herewith.

**35 USC 112, first**

2. Applicant contends that self assembled monolayers and passivation agents are described in the specification. Although the specification does not specifically recite that the two terms are interchangeable, one reasonably skilled in the art would recognize that the inventor intended the same subject matter. This argument was carefully considered but not found persuasive because the claims and specification teach an apparatus having a test chamber, a SAM monolayer, and a protein binding ligand attached to an electrode via a *spacer*. (See claim 20). The passivation agent is taught to be a spacer interchangeable with a conductive oligomer or insulator. Examiner has not found evidence in the specification or the prior art to support the interchange of a passivation monolayer with a SAM. Further, patentability cannot be predicated upon an advantage or result that has not been expressly or at least implicitly disclosed in the application as filed. Clinical Products v. Brenner, 255 F.Supp. 131, 149 USPQ 475, 480, (DDC1966).

**Rejection of Claims 20, 30, 34, under 35 USC 102(b)**

3. Applicant contends that Hollis et al. do not teach the instant invention because a passivation agent is not disclosed. This argument was carefully considered but not found persuasive because Hollis et al. disclose sensor array probes including a passivation layer (passivation agent monolayer) on page 29 lines 27-30 and in figure 26.

Art Unit: 1641

With respect to the examiner indicating that Hollis et al. do not teach passivation layers on page 6 of the office action mailed 10/25/04, it is noted that page 6 refers to the rejection of claims 22-23 and 31-33 under 35 USC 103 and the missing limitation from Hollis et al. regarded the inclusion of insulators and/or conductive oligomers along with the passivation agent. Accordingly, the rejection over Hollis et al. under 35 USC 102 (b) is maintained.

**Rejections under 35 USC 103 (a)**

4. Applicant argues that the rejections are not proper because Hollis et al. do not teach passivation agents. However, this argument has been addressed *a priori*. Hollis et al. disclose sensor array probes including a passivation layer (passivation agent monolayer) on page 29 lines 27-30 and in figure 26.

Applicant contends that the examiner has not supported the obviousness rejections with factual evidence. This argument was carefully considered but not found persuasive because each rejection under 35 USC 103 (a) is supported by way of specific references to pages and line number in each cited art. The rejections are maintained.

In response to applicant's argument that Kaymen, Kossovsky, and Wohlstadter are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all the cited art teach electrode devices having coated materials thereon. The rejections are maintained.

Art Unit: 1641

Applicant contends that the reference of Wohlstadter is not analogous art because it does not teach a processor configured to receive electrochemical signals, however the claims merely read on a processor to receive an output signal. The rejection is maintained.

5. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 – Central Fax number is (571) 273-8300, which is able to receive transmissions 24 hours/day, 7 days/week. In the event Applicant would like to fax an unofficial communication, the Examiner should be contacted for the appropriate Right Fax number.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (571) 272-0816. The examiner can normally be reached on Monday - Friday from 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (571) 272-0823.

Any inquiry of a general nature or relating to the status of this application should be directed to Group TC 1600 whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1641

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*Lisa V. Cook  
Patent Examiner  
Remsen 3C-59  
(571) 272-0816  
5/9/05*